

PATENT

Attorney Docket No. 20496-473

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Heimann et al.	GROUP NO.:	3726
APPLICATION NO.:	10/521,144	EXAMINER:	Chang, Rick Kiltae
FILING DATE:	September 6, 2005	CONF. NO.:	2748
PRIORITY APP NO.:	DE 102 35 957.1-14	PRIORITY DATE:	August 6, 2002
PCT APP NO.:	PCT/EP2003/08575	PCT DATE:	August 2, 2003
TITLE:	Method for Finishing Crankshafts for Motor Vehicle Engines		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully request review of the Final Office Action mailed January 19, 2010 in connection with the above-identified application*. This Request is filed concurrently with a Notice of Appeal, and no amendments are being filed with this Request. The review is requested for reasons provided herein.

Applicants hereby authorize the Commissioner to charge any fee that may be due in this application to Attorney's Deposit Account No. 50-3081.

Applicants respectfully request entry of this paper, in which:

- **Remarks** begin on page 2.

* Applicants note that a Request for Corrected Filing Receipt was filed on February 3, 2009 to correct errors in the Filing Receipt. However, Applicants are still awaiting the Corrected Filing Receipt to recognize foreign priority date to DE 102 35 957.1-14, filed June 8, 2002 as set forth in the Declaration filed September 6, 2005.

REMARKS

In the final Office Action, claims 1-7 and 9-13 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. For at least the reasons presented below, Applicants respectfully submit that the Examiner has failed to establish a proper rejection under 35 U.S.C. § 112, first paragraph.

I. The Final Office Action Is Based Upon Clear Factual Deficiency

Applicants submit that the Final Office Action is based on clear factual deficiency and thus is improper. Specifically, the Final Office Action misquotes Applicants' specification and uses this error as the basis of the 35 U.S.C. § 112, first paragraph rejection.

Specifically, the Examiner alleges that the claim element "deep rolling the roundings with a deep rolling tool; and while maintaining a distance interval to an individual transition in each case" is not supported by the specification. More particularly, the Examiner argues that the specification describes that "the roundings are deep rolled with a deep rolling tool, and then, maintaining a distance interval to the individual transition in each case." Office Action at page 2. To support this allegation, the Examiner erroneously curtails a full sentence in Applicants' specification by pointing to page 4, lines 7-9 of the specification. However, the sentence cited by the Examiner reads, in full, as follows:

To achieve the object, provision is made for the roundings
... to be deep rolled with a deep rolling tool, and then,
maintaining a distance interval to the individual transition
in each case, for the bearing position concerned to be
machined with removal of material with a small cutting
depth.

Specification at page 4, lines 4-11 as originally filed, emphasis added. Therefore, because the Examiner ignores the remainder of the sentence, the Examiner's reading of page 4, lines 7-9 of the specification is incomplete and erroneous.

As Applicant's specification was erroneously read and cited by the Examiner, Applicants respectfully submit that the 35 U.S.C. § 112, first paragraph rejection (the sole

rejection) is based upon a clear factual deficiency. Accordingly, Applicants respectfully request that the rejection be withdrawn.

II. The Final Office Action Fails To Establish A *Prima Facie* Case Under 35

U.S.C. §112, First Paragraph

The Final Office Action fails to support a *prima facie* case of lack of written description and thus is improper. MPEP § 2163 requires that to comply with the written description requirement of 35 U.S.C. § 112, paragraph 1, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. Applicants respectfully submit that each and every claim limitation is supported in the originally filed specification.

Claim 1 recites, in relevant part, “the process comprising: deep rolling the roundings with a deep rolling tool; and while maintaining a distance interval to an individual transition in each case, machining the bearing position concerned by removal of material with a small cutting depth.” That is, the process as claimed includes: (1) deep rolling the roundings with a deep rolling tool; and (2)(a) while maintaining a distance interval to an individual transition in each case, (b) machining the bearing position concerned by removal of material with a small cutting depth.

Applicants respectfully submit that the claim limitation at issue is supported by, for example, the originally filed specification at page 4, lines 4-11 as cited above. That is, lines 8-9, “maintaining a distance interval to the individual transition in each case” supports element (2)(a) above; lines 9-11, “for the bearing position concerned to be machined with removal of material with a small cutting depth” supports element (2)(b).

Support can be additionally found in the originally filed specification at page 6, last paragraph:

FIG. 4 shows the half-width of a bearing position 11. The bearing position 11 is deep rolled in the transition area 14 on both sides of the bearing position 11. ... The surface 16 of the bearing position 11 is then finish-machined by grinding with a grinding disk (not shown). In this situation, the grinding disk maintains a distance interval 17 from the two transitions 7. (Emphasis added.)

One skilled in the art would understand that, “In this situation, the grinding disk maintains a distance interval 17 from the two transitions 7” supports element (2)(a), i.e., while maintaining a distance interval to an individual transition in each case. “The surface 16 of the bearing position 11 is then finish-machined by grinding with a grinding disk” supports element (2)(b), i.e., machining the bearing position concerned by removal of material with a small cutting depth. Therefore, the specification as cited above reasonably conveys to one skilled in the art that the inventors had possession of the claimed invention.

For at least the foregoing reasons, Applicants respectfully submit that each element of independent claim 1 is supported by the specification as originally filed. Accordingly, Applicants respectfully request that the rejection of claim 1-7 and 9-13 under 35 U.S.C. § 112, first paragraph be reconsidered and withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants respectfully submit that the Examiner has failed to establish a proper rejection under 35 U.S.C. § 112, first paragraph. Applicants respectfully request that all rejections be withdrawn. All pending claims are in condition for allowance and early favorable action is respectfully requested.

Should the Examiner find that there are any issues outstanding after consideration of this Request, the Examiner is welcome to contact Applicants’ Attorney at the number below to expedite prosecution of the application.

Respectfully submitted,

Date: April 15, 2010

Reg. No.: 55,699

Tel. No.: (617) 526-9836

Fax No.: (617) 526-9899

/Deborah M. Vernon #55,699/

Deborah M. Vernon

Attorney for the Applicants

Proskauer Rose LLP

One International Place

Boston, MA 02110